

REMARKS

Claims 1-3, 5-9, 11-19, 31-49, 51 and 52 remain in this application. By this Amendment, claims 1, 9, 36, 41-49, 51 and 52 have been amended and claim 53 has been cancelled without prejudice or disclaimer.

Claims 1 and 9 are amended to replace each occurrence of the term "expression" with the term "transcription".

Claim 9 is also amended to reorganize the first two lines of the Markush group such that the subject matter is presented in a consistent form. Claim 9 is further amended to insert the phrase "nucleotides 1-1800 of SEQ ID NO:3", again, to ensure consistency with the Markush group.

Claims 36 and 41 are amended to remove reference to "nucleotides 61-655 of SEQ ID NO:7" and "nucleotides 61-855 of SEQ ID NO:7".

Finally, claims 42-49, 51 and 52 are merely amended to correct an antecedent basis error.

A. Item 7 of the Office Action

Claims 42-49 and 51-53 are objected to for being dependent on rejected base claims. All of the claims are allowable for the reasons discussed below. Therefore, withdrawal of the objection is respectfully requested.

Claims 52 and 53 are objected to for being duplicate claims. Claim 53 has been cancelled without prejudice or disclaimer. Therefore, withdrawal of the objection is respectfully requested.

B. Item 8 of the Office Action

Claims 36 and 41 are rejected under 35 U.S.C. 112, second paragraph, alleging that claims 36 and 41 broaden the scope of the claim from which they depend.

Claim 36 has been amended to remove the recitation "nucleotides 61-855 of SEQ ID NO:7; and nucleotides 61-655 of SEQ ID NO:7" and claim 41 has been amended to remove the recitation "a nucleotide sequence that hybridizes to nucleotides 61-855 of SEQ ID NO:7; and a nucleotide sequence that hybridizes to nucleotides 61-655 of SEQ ID NO:7".

Applicants submit that claims 36-41 as presently amended are consistent with the scope of parent claim 1, and removal of the rejection under 35 U.S.C. 112, second paragraph, is respectfully requested.

C. Item 9 of the Office Action

Claims 36 and 41 are rejected under 35 U.S.C. 112, first paragraph, alleging failure to comply with the Written Description requirement.

As discussed above with regard to Item 8, the objected-to subject matter has been removed from claims 36 and 41, without prejudice or disclaimer. Therefore, the rejection against claims 36 and 41 under 35 U.S.C. 112, first paragraph, is moot.

However, for reasons of record, Applicants submit that the subject matter of nucleotides 61-855 or 61-655 of SEQ ID NO:7 is reasonably inferable from the specification and drawings as originally filed, and Applicants maintain that the rejection of this subject matter as new matter is without merit.

The Office Action states at page 5 that, "It is noted that this domain is 18 amino acids larger than the acidic domain of AtHD2A. One skilled in the art would not have inferred this from the specification and drawings as filed." Applicants submit that Figure 4, and the legend to Figure 4, indicate that the sequence of the acidic domain of AtHD2A and AtHD2B is the underlined sequence. By comparing the sequences within the underlined region, it is clear that AtHD2B has 18 more amino acids than AtHD2A. Therefore, contrary to the assertion set forth in the Office Action, one skilled in the art could reasonable infer simply from Figure 4

what the acidic domain of AtHD2B is, and that it is 18 amino acids larger than the acidic domain of AtHD2A.

Therefore, despite removal of the subject matter of nucleotides 61-655 or 61-855 of SEQ ID NO:7 from the present application, Applicants assert that these sequences are not new matter, and reserve the right to submit claims to these sequences in a Divisional application.

D. Item 10 of the Office Action

Claims 1-3, 5-19, and 32-41 are rejected under 35 U.S.C. 112, first paragraph, alleging failure to comply with the enablement requirement. Specifically, the Office Action alleges at page 6 that "[t]here is no evidence at all in the specification, or the prior art, that histone deacetylases act by repressing translation, or by repressing any level of gene expression other than transcription".

Claims 1 and 9 have been amended so that "expression" now reads "transcription". Applicants submit, and as indicated by Examiner in the present Office Action, the present application provides support for the repression of transcription. Therefore, Applicants request withdrawal of the rejection to claims 1-3, 5-19 and 32-41 under 35 U.S.C. 112, first paragraph.

However, Applicants disagree with the allegation that the recitation "repression of gene expression activity" is not properly enabled within the specification, and reserves the right to pursue this subject matter in a Divisional application.

In the last paragraph of Item 10, the Examiner alleges that the subject matter of nucleotides 61-855 or 61-655 of SEQ ID NO:7 is not properly enabled, specifically alleging that "one skilled in the art could not have inferred from the specification as filed that, for example, the acidic domain of AtHD2B contains 18 more amino acids than the acidic domain of AtHD2A".

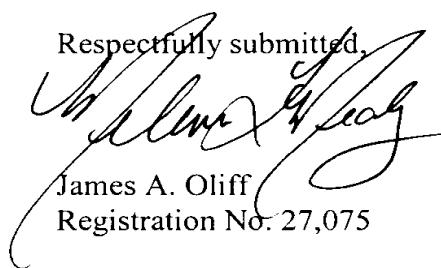
As discussed above with regards to Item 9, Applicants assert that one skilled in the art could easily determine from Figure 4, at the very least, that the acidic domain of AtHD2B contains 18 more amino acids than the acidic domain of AtHD2A, since this portion of the sequence is readily identified. However, for the purpose of expediting prosecution, and in no way acquiescing to the rejection, the claims have been amended to remove reference to nucleotides 61-855 or 61-655 of SEQ ID NO:7.

E. Closing

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-3, 5-9, 11-19, 31-49, 51 and 52 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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